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10/715,305

11/17/2003

Marten Dwight Marshall

5114

7590

01/30/2006

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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,305

Applicant(s)

MARSHALL, MARTEN DWIGHT

Examiner

Daniel J. Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 37-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Note to applicant: this Office action is an Ex Parte Quayle action which means that the claims have been found to contain allowable subject matter but have smaller issues (as outlined below) that need to be dealt with. Applicant may not make any substantial changes to the claims that modify the scope of patent protection at this point.

It is noted that the only effective way for applicant to comply with the below objection to claim 38 is to cancel that claim. However, it is clear that applicant wishes patent protection for a version of claim 37 without the step of printing an intermediate opaque white layer. Since the basis for allowance of the claims does not lie with the step of printing this layer, the examiner will accept additional new claims that recite the identical subject matter of claims 37, 39 and 40, only without the recitation of the step of printing the intermediate opaque white layer (i.e. step “d” in claim 37). Suitable adjustments to step “e” may also be made to compensate for the removal of step “d.”

If applicant wishes to expedite the process and avoid any administrative errors, he may call Examiner Colilla, at the below phone number so that these changes can be made by examiner’s amendment. *Note that applicant must respond within two months of the mailing of this Office action to avoid any additional time extension fees.*

2. This application is in condition for allowance except for the following formal matters:

Claim Objections

- Claims 37-40 are objected to because of the following informalities:

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- a. In claim 37, lines 3-4, “the objects” has no antecedent basis in the claims. In other words, applicant has not previously introduced the term “objects,” thus it is not clear what structure applicant is referring to. This objection could be overcome by removing the term “the” from before “objects.” The claim would be clearer if applicant were to recite, --leaving just selected objects in the pictures to be printed.--
- b. In claim 38, line 1, “said opaque white middle layer” has no antecedent basis in the claims. Applicant previously recited “an intermediate opaque white layer” in claim 37. Applicant should maintain the terminology to be clear. This objection could be overcome by replacing the term “middle” with --intermediate.--
- Claim 38 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In claim 38, line 1, the language, “without said opaque white middle layer” actually *modifies* the parent claim (claim 37) rather than *further limiting* it as is required. In other words, applicant cannot *remove* structure that was previously recited, but rather applicant must only provide further details in the claim to further limit the parent claim.

Appropriate correction is required.

Allowable Subject Matter

3. Claims 37-40 would be allowable if rewritten or amended to overcome the above mentioned objections, set forth in this Office action.

4. The following is a statement of reasons for the indication of allowable subject matter:

Claims 37-40 have been indicated as containing allowable subject matter primarily for the steps of removing the backgrounds from both single sided pictures and modifying the shapes of one or both objects in order to make the objects congruent such that the shape modification result in minimal distortion of the images.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kroner has been cited to show another example of printing a single two-sided picture from a first and second single sided picture.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 26, 2006

A handwritten signature in black ink, appearing to read "Daniel J. Colilla".

Daniel J. Colilla
Primary Examiner
Art Unit 2854